



41 3736  
H

PATENT  
Customer No. 22,852  
Attorney Docket No. 06530.0290

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: )  
Thomas O. BALES et al. )  
Application No.: 10/074,012 ) Group Art Unit: 3736  
(Reissue Application of Patent No. ) Prior Examiner: S. Gilbert  
6,024,708, Issued February 15, 2000) )  
Filed: February 14, 2002 )  
For: RADIAL JAW BIOPSY FORCEPS )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

RECEIVED

JUN 14 2004

TECHNOLOGY CENTER R3700

RESPONSE TO OFFICE ACTION

Claims 1-80 are pending in this application. No claim is being amended in this Response.

In the Office Action dated March 3, 2004, claims 1-80 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,264,617. Although Applicants do not necessarily agree with this rejection, Applicants submit herewith a Terminal Disclaimer to overcome the rejection in order to place this application in condition for allowance. The filing of this Terminal Disclaimer in no way manifests an admission by Applicants as to the propriety of the double patenting rejection. See M.P.E.P. § 804.02 citing Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

Applicants respectfully request the reconsideration of this application, the withdrawal of the double-patenting rejection, and the allowance of pending claims 1-80.

Applicants understand that the Examiner should determine whether all required maintenance fees have been paid up to date in the original patent, during the process of preparing the reissue application for issue. See M.P.E.P. § 1415.01. Applicants bring to the Examiner's attention that Applicants received a Notice of Patent Expiration dated March 17, 2004 indicating that the original patent (i.e., U.S. Patent No. 6,024,708) expired on February 17, 2004 for failure to timely pay the maintenance fee. Since the failure to pay the maintenance fee was unintentional, Applicants filed a Petition for Acceptance of Unintentionally Delayed Maintenance Fee Payment and Reinstatement of Expired Patent under 37 C.F.R. § 1.378(c) on April 26, 2004. The Petition is, to the best of undersigned's knowledge, currently pending.

Applicants also submit herewith the original patent (U.S. Patent No. 6,024,708) under 37 C.F.R. § 1.178(a). As detailed in a Statement of Inaccessible Original Patent filed on February 14, 2002, the original patent was inaccessible at the time of filing this reissue application. Since then, Applicants received a replacement of the original patent, which Applicants now surrender to the Patent Office.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 3, 2004

By: Leslie I. Bookoff  
Leslie I. Bookoff  
Reg. No. 38,084